

REMARKS

Applicant reiterates his oral election to prosecute the invention of species 3, claims 4-7, which election was made during a telephone conversation with the Examiner on June 9, 2004.

In his response for restriction under date of June 22, 2004, the Examiner stated that the captioned patent application contains claims directed to the following patentably distinct species of the claimed invention: Species I-FIGURES 1-4; Species II- FIGURES 5, 6A; Species III- FIGURES 6, 6A (elected); and Species IV- FIGURES 7, 7A. As indicated above, applicant has provisionally elected Species 3- FIGURES 6, 6A, including claims 4-7, for initial prosecution.

However, applicant respectfully traverses the Examiner's restriction requirement as follows: Reference is made to MPEP 808.02, which states "where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05 (c)-806.05(i), the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof... (B) a separate status in the art when they are classifiable together... (C) a different field of search... . MPEP continues "where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions". It is respectfully submitted that the Examiner has failed to establish reasons according to MPEP guidelines for insisting upon restriction, by failing to show that the various claim species belong to separate classification or fields of search or have acquired separate status in the art. While claims 1-3 do include a folded wing bird variation, it is respectfully submitted that claims 4-9 are drawn to a flying bird decoy, with claim 4 being generic and claims 5-9 set forth in dependent format, more particularly describing the number of arms and the number of mechanical flying birds attached to the arms, along with bearings in the

arms for easing rotation of the arms on the vertical support.

Accordingly, due to the overall structure, function and purpose of the various claimed species set forth in applicant's claims 4-9, it is respectfully submitted that all of the claimed species in this set of claims are classified together, occupy the same status in the art and are in the same field of search and, no reasons therefore exist for dividing among the related claimed inventions. Consequently, reconsideration and withdrawal of the Requirement for Restriction as applied to claims 8 and 9 and prosecution of claims 4-9 as a single invention, is respectfully solicited.

The Examiner further indicated that the Information Disclosure Statement filed on January 2, 2004, does not comply with 37 CFR 1.9A (a) (2), which requires a legible copy of each U.S. and foreign patent or publication to be forwarded with the Information Disclosure Statement. Applicant includes herein the following foreign patent documents: Great Britain- 6,11844; Italian- 624517; French-848634; Great Britain- 966,386; Sweden- 129,808; Italy- 262,806; Great Britain- 389,522; Great Britain- 406,386; France- 471,206; France- 264,6588; Europe- 127,9333; and German- 26674, as well as the Cabela's Catalog, page 261, "Motion Rabbit" ad. Reconsideration and consideration of this disclosure material in the captioned application is respectfully solicited.

The Examiner rejected claims 4 and 5 under 35 USC 102(b) as clearly anticipated by the patent to Sugimoto, U.S. 5,956,880. The Examiner's rejection is respectfully traversed as follows: A close review of the Sugimoto patent reveals that this patent is drawn to a bird repellent apparatus wherein a non-self-propelled bird having fixed wings is attached to a motor by means of a piano wire lead, such that the motor operates to "fly" the bird in a circle around the centrally located motor. The motor is attached to a support and variations in motor speed

facilitate variable planes in which the bird moves. There is no teaching, disclosure or suggestion of operating the bird in a self-propelled manner, since the wings are fixed and the driving force is clearly the motor which creates a centrifugal force on the bird, facilitating rotation of the bird in a selected plane at a selected speed around a fixed point. In contrast, applicant's amended independent claim 4 now recites a self-propelled mechanical flying bird connected to an arm for flying in a circle around a vertical support responsive to flapping of the wings of the mechanical flying bird. Reference is made to MPEP 2131, which states that in order for a reference to anticipate a claim, "the identical invention must be shown in as complete detail as is contained in the claim". *Richardson vs. Suzuki Motor Co.*, 868 Fed.2nd 1226, 1236; 9 USPQ 2nd 1913, 1920 (Fed.Cir. 1989). MPEP 2131 continues, "the elements must be arraigned as required by the claims... ." *In Re Bond*, 910 Fed. 2nd 831; 15 USPQ 2nd 1566 (Fed.Cir. 1990). It is respectfully submitted that the Sugimoto patent fails to show the "identical invention" defined by applicant's amended claim 4 and his dependent claims 5-7, as is required for anticipation by the Federal Circuit *In Richardson vs. Suzuki Motor Co.*, and further, the elements of the Sugimoto patent are not arranged as required by applicant's claims, a further requirement for anticipation by the Federal Circuit in *In Re Bond*. This is true, since the Sugimoto patent fails to require that the birds' wings flap and that his bird is self-propelled rather than be driven by a motor as disclosed. Accordingly, it is respectfully submitted that the Sugimoto patent fails to anticipate applicant's amended claim 4 and his remaining claims 5, 6 and 7, as well as claims 8 and 9, which are dependent upon claim 4. Reconsideration and allowance of applicant's claims 4-7, 8 and 9 as amended, is therefore respectfully solicited.

The Examiner further rejected claims 4-7 under 35 USC 102(e) as clearly anticipated by Powell, 2003/0196367. The Examiner's rejection is respectfully traversed as follows: the Powell

reference details a fixed wing wild fowl decoy attached to a wire, the opposite end of which wire is connected to a motor for driving the non-flying decoy in a circle around a floating platform. It is significant that the wild fowl decoy does not have movable wings nor does the decoy fly in a self-propelled manner, but, like the Sugimoto invention, is simply rotated about a fixed point by the motor. It is therefore respectfully submitted that the rationale of MPEP 2131 as described above and applied to Sugimoto is applicable, in that *Richardson vs. Suzuki Motor Co.* and *In Re Bond* both apply. Accordingly, it is respectfully submitted that the Powell patent fails to show the “identical invention” as that defined in each of applicant’s amended claims 4-7, 8 and 9 and specifically claim 4 as amended, as required for anticipation by the Federal Circuit *In Richardson vs. Suzuki Motor Co.* Furthermore, the elements of the Powell patent are not arranged as required by applicant’s claims, another requirement for anticipation by the Fed.Cir. in *In Re Bond*. Accordingly, it is respectfully submitted that the Powell patent fails to anticipate applicant’s amended independent claim 4 and his dependent claims 5-9 and reconsideration and allowance of applicant’s 4-9 as amended, is therefore respectfully solicited.

The Examiner further rejected applicant’s claims 4-7 under 35 USC 102(b) as clearly anticipated by the patent to Sabin, U.S. 2,547,286. The Examiner’s rejection is respectfully traversed as follows: The Sabin patent details multiple animated decoys placed on the end of respective extending rods, which rods are attached to a vertical shaft and a motor for driving the decoys in a circle. There is no teaching, suggestion or disclosure of self-propelled decoys, the decoys all appearing to have folded wings, in the Sabin disclosure. Accordingly, it is further respectfully submitted that the Sabin patent suffers from the same deficiency as the Powell and Sugimoto disclosures, in that there is no teaching, suggestion or disclosure of movable flapping wings that self-propel one or more decoys on a pivoting arm or arms. It is further respectfully

submitted that the elements in the Sabin patent are not arranged as required by amended claims 4-9 of applicant's application, as mandated by *In Re Bond*. Furthermore, the Sabin patent fails to show the "identical invention" as defined in each of applicant's amended claims 4-9, as further required for anticipation by the Fed.Cir. *In Richardson vs. Suzuki Motor Co.*, described above. Accordingly, it is respectfully submitted that the Sabin patent fails to anticipate applicant's amended claims 4-9 and reconsideration and allowance of these claims is therefore respectfully solicited.

The Examiner further rejected claims 4-7 under 35 USC 102(b) as clearly anticipated by the patent to Holt, U.S. 4,135,711. A close review of the patent to Holt indicates that this patent is drawn to a tethered airplane assembly which includes a vertical pole, to which are attached model airplanes that fly around the pole on the tether. The patent does not teach or suggest the use of a decoy, nor does it indicate any flapping wings on the airplanes to self-propel the airplanes by flapping wing motion around the pole. Rotation of the airplanes around the pole is clearly facilitated by propeller action as the electric motor-operated airplanes fly in a circle around the pole. Again, it is respectfully submitted that the Holt patent falls in the same category as the previously described references of record under the mandate of MPEP 2131. More specifically, the elements of the Holt patent are not arranged as required by applicants' claims and as further required by *In Re Bond*, described above. It is further respectfully submitted that the Holt patent fails to show the "identical invention" as that defined by each of applicant's amended claims 4-9, which mandate is required for anticipation by the Federal Circuit in *In Richardson vs. Suzuki Motor Co.* Accordingly, reconsideration and allowance of applicant's amended claims 4-9 is respectfully solicited.

The Examiner further rejected claims 6 and 7 as unpatentable under 35 USC 103(a) over

the patent to Sugimoto, U.S. 5,956,880. The Examiner indicated: “Sugimoto discloses the claimed invention except for the use of two mechanical flying birds. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to utilize two mechanical flying birds, since it has been held that mere duplication of the essential working parts of a device involve the only routine skill in the art. And because using two mechanical birds would make a natural presentation by representing a gathering of birds”, *St. Regis Paper Co. vs. Beamis Co.*, 193 USPQ.

The Examiner’s rejection of claims 6 and 7 under 35 USC 103(a) considering the patent to Sugimoto is respectfully traversed as follows: As described above, the Sugimoto patent is drawn to an apparatus for rotating fixed wing bird in a circle by operation of a motor and piano wire tether. There is no teaching or suggestion in the Sugimoto patent of using one or more self-propelled flying birds, which flying action is maintained by the flapping of the flying bird wings. It is respectfully submitted that the teaching or suggestion to make the claimed combination of flying birds to the Sugimoto fixed wing bird patent, as well as a reasonable expectation of success in doing so, cannot reasonably be found in the prior art and is, instead, based on the applicant’s disclosure. MPEP Sec.706.020 (K) at Page 700-45, outlines the requirements for a prima facie case of obviousness and to establish this prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim limitations and the reasonable expectation of success must be found in the prior art and not based

on applicant's disclosure, see *In re Vaeck*, 20 USPQ 2nd 438 (Fed.Cir.1991). It is respectfully submitted that there is no reasonable suggestion or motivation in the Sugimoto patent to attach a wing-flapping, self-propelled flying bird to the Sugimoto tether, since the Sugimoto fixed wing bird is propelled by a motor and a tether combination. It is therefore respectfully submitted that applicant's application of the flying bird to the Sugimoto tether is hindsight gleaned from applicant's disclosure. It is further respectfully submitted that there is found no reasonable suggestion or motivation in Sugimoto to apply the flying bird concept to the invention in that patent, since Sugimoto clearly uses a motor as the driving force to propel the fixed wing bird in a circle around the motor. There is no need for a self-propelled, flying bird in Sugimoto.

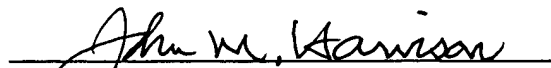
It is further respectfully solicited that to apply the flying bird decoy to the Sugimoto tether and the motor combination would make the device inoperable for the purpose for which it was intended. The self-propelled flying bird would be forced around the circle by the motor and at the same time, would operate in a flapping wing manner, which would make the device inoperable, since the bird would be forced around the circle faster than its intended self-propelled speed.

Accordingly, it is respectfully submitted that one skilled in the art would not logically and reasonably be led to applicant's invention as embodied in his amended claims 4-9 by the Sugimoto patent, taken alone or in combination, and reconsideration and allowance of amended claims 4-9 is therefore respectfully solicited.

Every effort has been made to amend applicant's claims in order to define his invention

in the scope to which it is entitled. Accordingly, reconsideration and allowance of applicant's claims 4-7 as well as claims 8 and 9, is respectfully solicited.

Respectfully submitted,

A handwritten signature in cursive script, reading "John M. Harrison", is written over a horizontal line.

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